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EXAMINER CHENCINSKI, SIEGFRIED E				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/827,333

**Applicant(s)**

QURAIISHI ET AL.

**Examiner**

SIEGFRIED E. CHENCINSKI

**Art Unit**

3695

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-13 and 29-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-13 and 29-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO-8300)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 3, 2009 has been entered.

### **2. Status of Claims**

Amended claims 6-13 and 29-40 are now active for prosecution.

### **Applicant Admitted Prior Art**

3. Applicant has admitted that the items for which the examiner took Official Notice in rejecting dependent claims 7 -13 in the last Office Action were prior art at the time of Applicant's invention. Accordingly these items are now Applicant Admitted Prior Art (hereafter AAPA). MPEP 2104 C 2nd parag. - AAPA - Applic. Admission due to lack of or inadequate Travelsal:

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

These AAPA features are:

**Re. Claim 7**, in which the assigned scope of application level specifies a specific account.

**Re. Claim 8**, in which the assigned scope of application specifies a specific registered representative.

**Re. Claim 9**, in which the assigned scope of application is level specifies a specific office.

**Re. Claim 10**, in which the assigned scope of application level specifies a specific firm.

**Re. Claim 11**, in which the assigned scope of application is set to the global level.

**Re. Claim 12**, in which a rule is accompanied by a message to be sent when a rule is violated.

**Re. Claim 13**, in which the text of said message can be changed by a user for a selected level.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 6, 16, 17, 22 & 24, are rejected** under 35 U.S.C. 103(a) as being unpatentable over Stein et al. (US Patent 5,978,779, hereafter Stein) in view of AAPA.

**Re. Claims 6 & 31**, Stein discloses a system and program storage medium for processing a transaction containing an order for execution.

Stein further discloses:

- accessing a plurality of rules, each respective one of the rules having a preset scope of application specifying a scope of source of transactions for which the respective rule should apply to all transactions from any source within the specified scope (Col. 3, l. 23 – Col. 4, l. 24; Col. 2, ll. 25-29, 39-43 covering a global financial services organization; Col. 11, l. 66 – Col. 12, l. 7; Stein uses the

word "rules" and synonyms thereof such as the words "constraints", "logic" and "protocols" interchangeably in Applicant's meaning of "rules"); and

- checking the transaction containing the order to determine whether or not to execute the order contained in the transaction by first applying rules having application scope specifying a specific account, then applying rules having application scope specifying a specific registered representative, then applying rules having application scope specifying a specific office, then applying rules having application scope specifying a specific firm and then applying rules having application scope applicable to transactions from all sources. (pre-defined and universally applied protocols – Col. 2, ll. 28-29; rules hierarchy – col. 3, l. 36; Hierarchical protection – Col. 7, ll. 9-12; Internal and external/Governmental rules and relationships stored in the document library – Col. 5, l. 6-23).
- the transactions of order execution (Col. 2, ll. 44-45 – buying and selling) and asset transfers between accounts (Col. 2, ll. 45 – distribution; Col. 3, l. 52; Col. 5, ll. 19-20; Col. 6, ll. 28-30; Col. 8, l. 17), and also discloses user settings (Col. 2, ll. 25-36, 39-43; Col. 5, ll. 25-27; Col. 7, ll. 10-13). a) an interface for receiving a plurality of transactions, each transaction containing a request either (1) for an order to be sent to a market for execution or (2) for execution of an asset transfer from an account (Col. 2, ll. 37-64),

Applicant defines "scope" as a hierarchical "level" (Fig. 5, 520). Page 8, ll. 6-21 of the specification supports and explains this definition. Hence, generically, level and scope are interchangeable expressions representing a hierarchical organization concept having four levels, from a particular account to the broker-dealer firm itself. This and the additional words added by amendment have not changed the patentable meaning of these claim limitations under the obviousness statute.

AAPA discloses in which the assigned scope of application level: specifies a specific account, a specific registered representative, a specific office, a specific firm, is set to the global level, in which a rule is accompanied by a message to be sent when a rule is violated and in which the text of said message can be changed by a user for a selected level.

Even though Stein does not exactly disclose Applicant's specific descriptions, Stein's system and program storage medium do cover Applicant's invention, with the system of claim 6 as exemplary, comprising the steps of:

b) a storage medium having rules stored thereon for determining whether or not to allow execution of a requested order or asset transfer, the rules having parameters for analysis of the requested order or asset transfer and a plurality of preset levels of scope of application, wherein:

each rule has an assigned a level of scope of application selected from the plurality of preset levels,

each preset level of scope of application specifies a scope of source of transactions for which a corresponding rule should apply to all transactions from any source within the specified scope, and

the assigned level corresponding to each rule is adjustable from a first one of the plurality of preset levels to a second one of the plurality of preset levels based on a user setting; and

c) an order/transaction processing section having access to the storage medium, for applying at least one of the rules to each respective received transaction based on source and level of the respective received transaction being within the specified scope of the each applied rule, to determine whether or not to allow execution of the requested order or asset transfer contained in the respective received transaction, wherein:

upon determining to automatically approve execution of the requested order or asset transfer contained in a first received transaction, based on application of at least one of the rules to the request for the order or asset transfer in the first received transaction, the order/transaction processing section forwards the order or the asset transfer in the request contained in the first received transaction to an execution process for fulfillment; and upon the application of at least one of the rules to a second received transaction indicating a manual user approval is required for execution of the order or asset transfer, in the request contained in a second received transaction, the order/transaction processing section forwards the

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request for the order or asset transfer contained in the second received transaction to a user for possible manual approval for execution for fulfillment.

The difference in independent claim 31 compared to independent claim 6 is that "each rule has an assigned outcome selected from a plurality of preset outcomes". However, given the large use of preset rules in Stein as documented above, the ordinary practitioner of the art would have found it obvious to have also established preset outcomes in the rules.

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used the disclosure of Stein combined with AAPA and the practitioner's own knowledge to produce Applicant's invention of a system and program storage medium for processing a transaction containing an order for execution, motivated by a desire to create a unified infrastructure for control and data transfer to a plurality of function and task specific applications (Stein, Col. 2, ll. 18-21).

**Re. Claims 7-13,** Stein does not explicitly disclose:

**Re. Claim 7,** in which the assigned level of scope of application of an applied rule specifies a specific account.

**Re. Claim 8,** in which the assigned level of scope of application of an applied rule specifies a specific registered representative.

**Re. Claim 9,** in which the assigned level of scope of application of an applied rule specifies a specific office.

**Re. Claim 10,** in which the assigned level of scope of application of an applied rule specifies a specific firm.

**Re. Claim 11,** in which the assigned level of scope of application of an applied rule is set to the global level.

**Re. Claim 12,** in which a rule is accompanied by a message to be sent when a rule is violated.

**Re. Claim 13,** in which the text of said message can be changed by a user for a selected level.

However, AAPA discloses claims 7-13. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used the disclosure of Stein and AAPA combined with his own knowledge to produce Applicant's invention of a method, system, device, apparatus and program storage device for processing a transaction containing an order for execution, motivated by a desire to create a unified infrastructure for control and data transfer to a plurality of function and task specific applications (Stein, Col. 2, ll. 18-21).

**Re. Claim 17**, Stein discloses compliance rules (Col. 5, ll. 8-11).

**Re. Claims 32-36**, Stein does not explicitly disclose:

**Re. Claim 32**, in which the assigned level of scope of application of an applied rule specifies a specific account.

**Re. Claim 33**, in which the assigned level of scope of application of an applied rule specifies a specific registered representative.

**Re. Claim 34**, in which the assigned level of scope of application of an applied rule specifies a specific office.

**Re. Claim 35**, in which the assigned level of scope of application of an applied rule specifies a specific firm.

**Re. Claim 36**, in which the assigned level of scope of application of an applied rule is set to the global level.

However, AAPA discloses claims 32-36. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used the disclosure of Stein and AAPA combined with his own knowledge to produce Applicant's invention of a method, system, device, apparatus and program storage device for processing a transaction containing an order for execution, motivated by a desire to create a unified infrastructure for control and data transfer to a plurality of function and task specific applications (Stein, Col. 2, ll. 18-21).

**Re. Claim 37**, neither Stein nor AAPA explicitly disclose a rule accompanied by a message to be sent when a rule is violated. However, it would have made common sense to the ordinary practitioner based on well established practices to send a



message to one or more affected parties that a rule has been violated and informing eh parties of the rule which has been violated). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used the disclosure of Stein and AAPA combined with his own knowledge to produce Applicant's invention of a method, system, device, apparatus and program storage device for processing a transaction containing an order for execution, motivated by a desire to create a unified infrastructure for control and data transfer to a plurality of function and task specific applications (Stein, Col. 2, ll. 18-21).

**Re. Claim 38**, in which the text of said message can be changed by a user for a selected level (Col. 6, ll. 2-5; the user makes changes to information as a revision. This suggests to the ordinary practitioner that user changes can be made to various messages documents in the system).

**5. Claims 29 & 30 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Stein in view of AAPA a applied to claim 6 and 30 above, and further in view of Lutnick et al. (US Patent 6,850,907 B2, hereafter Lutnick).

**Re. Claims 29 & 39**, Stein and AAPA disclose wherein upon the application of at least one of the rules to a third transaction: the order/transaction processing section forwards the requested order or asset transfer contained in the third received transaction to an execution process for fulfillment (See the rejection of claim above).

Neither Stein or AAPA explicitly disclose the sending of a warning message regarding a requested transaction. However, Lutnick discloses sending a warning message regarding a requested transaction (Col. 5, l. 2).

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used the disclosure of Stein and AAPA and Lutnick combined with his own knowledge to produce Applicant's invention of a method, system, device, apparatus and program storage device for processing a transaction containing an order for execution, motivated by a desire to create a unified infrastructure for control and data transfer to a plurality of function and task specific applications (Stein, Col. 2, ll. 18-21).

**Re. Claim 30 & 40**, the disclosures of Stein and AAPA are cited above. Neither Stein or AAPA explicitly disclose stopping execution of a transaction request. However, Lutnick discloses rules automatically the execution transaction requests by participants (Col. 32, l. 55). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have used the disclosure of Stein and AAPA and Lutnick combined with his own knowledge to produce Applicant's invention of a method, system, device, apparatus and program storage device for processing a transaction containing an order for execution, motivated by a desire to create a unified infrastructure for control and data transfer to a plurality of function and task specific applications (Stein, Col. 2, ll. 18-21).

### ***Response to Arguments***

6. Applicant's arguments filed March 3, 2009 with respect to claims 6-13 and 29-40 have been considered but they are moot in view of the new grounds of rejection.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Charles Kyle, can be reached on (571) 272-6746.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks, Washington D.C. 20231*

or (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

March 25, 2009

/Narayanswamy Subramanian/  
Primary Examiner, Art Unit 3695